

Amendments to the Drawings:

The attached Replacement sheets of drawings for Figs. 1 to 10, and 15 to 19 are submitted in response to the drawing objections as to the inclusion of descriptive labels, as detailed in the Office Action. Approval and entry are respectfully requested, and withdrawal of the objections is respectfully requested.

Attachment: Fourteen (14) Replacement Sheets

REMARKS

I. Introduction

Claims 18 to 24 and 26 to 46 are currently pending in the present application, since claims 1 to 7 and 25 were previously canceled. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for the indication that the Restriction requirement of May 18, 2006 has been withdrawn.

II. Information Disclosure Statement

The Office Action objects to the listing of numerous references in the Information Disclosure Statements (IDS) of May 24, 2004 and November 9, 2006. As an initial matter, Applicants regard all of the listed references as pertinent since they either have been cited in other patent applications filed by one or more of the present Applicants and cross-referenced with the present application, or the references were uncovered during searches by Applicants. For example, the present application cites U.S. Patent Application No. 10/265,846 which is believed to be referenced by, and to reference, still other patent applications filed by the present Applicants.

Further, the Office Action asserts that M.P.E.P. § 2004 requires Applicants to eliminate or otherwise underline some of the references cited in the filed Information Disclosure Statements. The Office Action further states that “the references cited in the IDS of 5/24/04 will not be considered until an *underlining* of the most relevant documents is provided.” Office Action, page 2. Applicants respectfully traverse this requirement. M.P.E.P. § 2004 merely provides “suggestions for avoiding duty of disclosure problems”; it does not require compliance with any of the suggestions.

With respect to the Examiner’s indication that the references cited in the IDS of May 24, 2004 will not be considered unless Applicants comply with M.P.E.P. § 2004, while Applicants appreciate the Examiner’s hesitancy to consider all of the cited references in the IDS, Applicants remind the Examiner that, as set forth in 37 C.F.R. § 1.97 and in M.P.E.P. § 609, “an information disclosure statement filed in accordance with the provisions of 37 CFR 1.97 and 37 CFR 1.98 will be considered by the examiner assigned to the application” and “[o]nce the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, ***the examiner has an obligation to consider the information.***” M.P.E.P. § 609 (emphasis added).

III. Requirements

The Office Action provides a laundry list of requirements to which Applicants assertedly must adhere, without providing any basis for the requirements. For example, the Office Action requires Applicants to “[p]rovide how the instant claimed invention is an improvement over each and every reference that is listed in the IDS submission(s).” Office Action, page 3. This requirement appears to impose upon Applicants a requirement normally imposed when filing a petition to make special, which is not applicable in the instant case. Furthermore, M.P.E.P. § 609.04(a)(III) limits the instances where an IDS must include a concise explanation of relevance to non-English language information.

Similarly, with respect to the requirements for furnishing copies of literature, the requirements listed in the Office Action appear to require more than specified in M.P.E.P. § 609.04(a)(II).

Accordingly, with respect to each of the requirements A-F listed in the Office Action, Applicants traverse the requirement and request that the Examiner point to a particular rule upon which the Examiner relies as the basis for the requirement.

IV. Amendment to the Drawings

In response to the objection to the drawings, Replacement sheets of drawings are submitted to address the objection to the drawings. Figs. 1 to 10 and 15 to 19 have been amended herein without prejudice to include descriptive labels. No new matter has been added. Approval and entry are respectfully requested. Withdrawal of the objections is therefore respectfully requested.

V. Rejection of Claims 18 to 24 and 26 to 46 Under 35 U.S.C. § 112, ¶ 1

Claims 18 to 24 and 26 to 46 were rejected under 35 U.S.C. § 112, ¶ 1 as allegedly failing to comply with the enablement requirement. The present rejection should be withdrawn for at least the following reasons.

The Office Action asserts that the claims are not enabled because at least some of the claims do not expressly require testing and “[t]he Specification is almost entirely directed to testing by using algorithms.” Office Action, page 6.

As regards the enablement requirement, the standard for determining whether a patent application complies with the enablement requirement is that the specification describe how to make and use the invention — which is defined by the claims. (*See* M.P.E.P.

§ 2164). The Supreme Court established the appropriate standard as being whether any experimentation for practicing the invention was undue or unreasonable. (See M.P.E.P. § 2164.01 (citing *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916); *In re Wands*, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988))). Thus, the enablement test is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” (See *id.* (citing *United States v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (See *id.* (citing *In re Wands*, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). In this regard, the Federal Circuit has also stated that it is “improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that the examiner’s analysis must therefore “consider all the evidence related to each of these factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” (See M.P.E.P. § 2164.01). It is respectfully submitted that the Office Action has not addressed these factors.

It is believed that the present assertions of the Office Action do not meaningfully address — as they must under the law — whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation — which it plainly does. In short, it is believed that the Office Action’s assertion that “[t]he Specification is almost entirely directed to testing by using algorithms,” does not address the issue of whether one having ordinary skill would have to *unduly experiment* to practice the claimed subject matter of the rejected claims — a proposition for which the Office bears the burden of proving a *prima facie* case as to the rejected claim.

It is therefore respectfully submitted that the Office Action has plainly failed to establish that the claim does not comply with the enablement requirement of 35 U.S.C. § 112. Notwithstanding the foregoing, it is respectfully submitted that the claim fully complies with the requirements of 35 U.S.C. § 112 for the following additional reasons.

The Specification describes and explains how to practice the subject matter in each of the pending claims. For example, with respect to claim 18, the Specification describes running a first program on cells of an integrated circuit, saving data from the cells to a memory in response to a waiting condition, e.g., a wait or IDLE cycle, running a second program on the cells after the data is saved, and subsequently reloading the saved data back into the cells. See Specification, e.g., page 9, lines 14 to 28. While the Specification may refer to a particular example in which the second program is a test program and thereby additionally provide a novel method of testing the cells, nowhere does the Specification indicate that the second program must be a test program. Additionally, the cited section of the Specification refers to the loading of a new program, *i.e.*, even one that is not a test program, before continuation of the program that has reached an IDLE state. In this regard the Specification states that “[n]ew test data can be loaded until the IDLE cycle is ended by the arrival of new data to be processed, by a new program to be executed or by another request.” Specification, e.g., page 9, lines 25 to 28 (emphasis added). Further, one having skill in the art would understand that a program other than a test program may be run as the second program after saving the data of the cells to memory. Similarly, notwithstanding the omission in the other claims of limitations that refer to testing, the Specification similarly enables one skilled in the pertinent art to practice the claimed subject matter of the other pending claims without undue experimentation.

In view of all of the foregoing, it is respectfully submitted that the claims fully comply with the enablement requirement of 35 U.S.C. § 112, ¶ 1. Withdrawal of the rejection is therefore respectfully requested.

VI. Rejection of Claims 18 to 24 and 26 to 46 Under 35 U.S.C. § 112, ¶ 2

Claims 18 to 24 and 26 to 46 were rejected under 35 U.S.C. § 112, ¶ 2 as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The present rejection should be withdrawn for at least the following reasons.

The Office Action asserts that the claims are indefinite because the claims do not expressly require testing and “[t]he Specification is almost entirely directed to testing by using algorithms.” Office Action, page 7. The Office Action further states that “the examiner would like to be informed what type of programs and data processing within the scope of the specification are being presented as claims.” *Id.* However, the Office Action has not indicated which limitations recited in any of the claims (besides for claims 21, 27, 29,

37, 41, and 46, which are addressed below) are unclear. That the claims are not more narrowly written to recite additional limitations regarding the particular programs used and data processing performed does render the recited features indefinite.

To the extent the rejection is based on the Examiner's belief that the claims are overbroad because they may read on numerous types of programs for use as the second program recited in the claims and do not limit the second program to a test program, it is noted that the breadth of a claim is an inappropriate basis for a rejection of the claim. As § 2173.04 of the M.P.E.P., entitled "Breadth Is Not Indefiniteness," states: "Breadth of a claim is not to be equated with indefiniteness." See also *In re Miller*, 169 USPQ 597 (CCPA 1971). Regardless of breadth, if the scope of the subject matter embraced by the claims is clear, and "[i]f applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. § 112, second paragraph." MPEP § 2173.04. A claim therefore can both be broad and, at the same time, clearly demarcate to those of ordinary skill in the art the boundaries of Applicant's invention. In order to establish that these claims are too broad, that is, that the scope of invention to which Applicants are striving to attain, e.g., without more particularly reciting particular programs for use as the second program, is more than what they are entitled to under the Patent Act, specific evidence in the form of references or other publications must be brought forth by the Patent Office. Therefore, the issue of breadth is one that pertains not to the understandability of the claims, since claims that are broad are not inherently indefinite, but to the outer limits of what Applicants are entitled to exclude others from making, using, or selling, limits which are bounded by what is in the public domain and also by what others have already staked out for themselves as their own property. In other words, the proper rubrics for examining the issue of breadth are those of anticipation and obviousness under §§ 102 and 103. Thus, even if the claims are broad in scope, the claims are, nevertheless, clear, give no rise to ambiguity, and, therefore, definite.

With respect to claims 21, 27, 29, 37, 41, and 46, the Office Action states that "[t]his is also indefinite as claims 21, 27, 29, 37, 41, and 46 recite testing and or test routines." Office Action, page 7. It is not clear what about these features the Examiner finds unclear. To the extent the rejection is based on the inclusion in these dependent claims of additional limitations that more narrowly define the second program recited in their respective base claims, it is noted that not only may a dependent claim specify a further limitation of the subject matter claimed in its base claim, 35 U.S.C. § 112, fourth paragraph requires it.

With respect to claims 27 and 29, the Office Action asserts that there is insufficient antecedent basis for the limitation "the test routine program." Applicants respectfully traverse this assertion since each of claims 27 and 29 depends from claim 44 which recites "the second program is a test routine program."

Accordingly, because 18 to 24 and 26 to 46 are already clear and give rise to no ambiguity when read correctly, no amendment is deemed necessary.

Thus, claims 18 to 24 and 26 to 46 are clear, give no rise to ambiguity, and therefore definite. Withdrawal of this rejection is therefore respectfully requested.

VII. Conclusion

In light of the foregoing, it is respectfully submitted that all of the presently pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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